



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,216	05/18/1999	DAVID L. SILVERMAN	3432.80970	3594

7590 02/26/2002

BANNER & WITCOFF LTD
1001 G STREET N W
WASHINGTON, DC 200014597

EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
----------	--------------

2161

DATE MAILED: 02/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/313,216

Applicant(s)

SILVERMAN ET AL.

Examiner

Edward R. Cosimano

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-28 is/are pending in the application.
- 4a) Of the above claim(s) None is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 2/16/00 & 8/30/00 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.
2. Prosecution on the merits of this application is reopened on claims 12-28 considered unpatentable for the reasons indicated below.
 - 2.1 Applicant is advised that the Notice of Allowance mailed November 20, 2000 is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.
3. The drawings filed December 19, 1995 are objected to because:
 - A) the drawings must show every feature of the invention specified in the claims, therefore, the subject matter of claim(s) 12-28, in regard to a single display with 4 to 7 sections as recited, must be shown in the drawings as required by 37 CFR § 1.83(a) or the feature(s) canceled from the claim(s) (note: no new matter should be entered).

Correction is required.

 - 3.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
 - 3.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.
4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in

correcting any errors of which applicant may become aware in the specification or drawings.

Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(g)-1.121(h).

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5.1 Claims 12-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Sibley, Jr. (4,677,552) or Shavit et al (4,799,156) or Wagner (4,903,201 or 4,980,826) or Silverman et al (5,077,665 or 5,136,501) or Wiseman (5,168,446) in view of an obvious need.

5.1.1 In regard to the displaying of trading information as recited in claims 12-28, since either Sibley, Jr. ('552) or Shavit et al ('156) or Wagner ('201 or '826) or Silverman et al ('665 or '501) or Wiseman ('446) require an user to input data about offers to either buy or sell items, it would have been obvious to one of ordinary skill at the time the invention was made that the systems of either Sibley, Jr. ('552) or Shavit et al ('156) or Wagner ('201 or '826) or Silverman et al ('665 or '501) or Wiseman ('446) would display the information about the offers and trades to the user so that the user may make an informed decision about the offer to either sell or buy.

5.1.2 In regard to the displaying of "non-negotiable values" and "negotiable values", since it is common practice in the instant environment to have conditions/instructions attached to an

offer to either sell or buy, it would have been obvious to one of ordinary skill at the time the invention was made that some of the conditions/instructions for an offer to sell/buy in any one of Sibley, Jr. ('552) or Shavit et al ('156) or Wagner ('201 or '826) or Silverman et al ('665 or '501) or Wiseman ('446) would have both "non-negotiable values" and "negotiable values" within the offer's conditions/instructions.

5.1.3 In regard to the material/data/information provided/displayed to the user in the claimed portions/regions, since the type of data displayed does not affect the function of the claimed system, this material/data/information is considered to be "non-functional descriptive material" and hence does not add patentable weight to the claims. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are: ... - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

6. Response to applicant's arguments.

6.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.


6.2 As per the objection to the drawings, since the claims recite that the display contains from 4 to 7 display portions without specifying whether or not the 5th, 6th & 7th display portions are displayed simultaneously with the 1st through 4th display portions, this objection is maintained.

7. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)-305-9768. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

- 8.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.
- 8.2 The fax phone number for OFFICIAL FAXES is (703) 746-7239.
- 8.3 The fax phone number for AFTER FINAL FAXES is (703) 746-7238.

02/25/02


Edward R. Cosimano
Primary Examiner A.U. 2161